

172. (previously presented) The method of claim 170 wherein said device is a stent.

173. (previously presented) The method of claim 170 wherein said device is a stent-graft.

### **REMARKS**

Claims 1-173 are pending in this application. Claims 24-32 and 41-47 have been withdrawn from consideration. Claims 33-40 have been cancelled.

Claims 1-15, 17-20, 48, 50-52, 55, 57-75, 77, 82, 85-86, 88-109, 111-114, 118, 120-122, 125, 127-145, 147, 152, 156, and 158-171 have been rejected under 35 U.S.C. §102(b) as being anticipated by Schubert (German Patent No. DE 3402573 A1). Applicants respectfully traverse these rejections.

Applicants note that Schubert does not disclose a stiffened dilating balloon comprising a plurality of stiffening members. The “numerous fine individual blades” (1) disclosed by Schubert do not constitute stiffening members in that they are so small, relative to the size of the balloon - see Schubert Figure 8 - that they do not appreciably stiffen the balloon.

Claims 1, 95, 165 and 166 have been amended to clarify the interconnection of the stiffening members. In each claim the word “directly” has been inserted to make clear that at least one of the stiffening members is directly connected to another one of the stiffening members by a filament. In contrast, the Examiner has asserted that “filaments 4 *indirectly* connect[]” blades (1) of Schubert together. While Applicants do not agree with the Examiner’s assertion, Applicants’ amendment of the claims clarifies this difference between the present invention and the disclosure of Schubert.

Applicants disagree with the Examiner's further assertion that the threads (4) of Schubert "can be considered as elastic or inelastic because "elastic" and "inelastic" are relative terms." The use of relative terms in claim drafting is a common practice and the meaning of such terms should not be disregarded by the Examiner. There is no suggestion in Schubert that threads (4) are elastic.

Applicants further disagree with the Examiner's assertion that the Schubert reference "inherently discloses a method of using the device as recited in the claims." Applicants request that the Examiner specifically identify the text of Schubert upon which the Examiner relies. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." M.P.E.P. § 2112 citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in the original). Here, the Examiner has not identified any basis at all for a finding of inherency. Applicants maintain that Schubert does not disclose the methods set forth in claims 167-171. Schubert certainly does not disclose the methods of claims 170-171 as Schubert makes no mention at all of using an expandable balloon to dilate a separate device.

Claims 16, 21-23, 49, 53-54, 56, 76, 78, 80-81, 83-84, 87, 110, 115-117, 119, 123-124, 126, 146, 148-151, 153-155, 157 and 172-173 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Schubert. Applicants respectfully traverse these rejections. The Examiner has failed to establish a prima facie case of obviousness. Even if Schubert did "disclose[] substantially all structural limitations of the device as claimed," which it does not, "the mere fact that one of ordinary skill in the art could rearrange parts of the reference device to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. The

prior art must find a motivation or reason for the worker in the art, without the benefit of applicants' specification to make the necessary changes in the reference device." M.P.E.P. §2144.04 quoting *Ex Parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. of Pat. App. & Inter. 1984). The Examiner neither identifies any corresponding structure in Schubert nor any motivation in the prior art to modify that structure and, therefore, has failed to establish any grounds for an obviousness rejection.

Applicants further disagree with the Examiner's assertion in connection with claims 172 and 173 that Schubert discloses "projections to engage and secure a stent/stent-graft during deployment along a tortuous vessel." Claims 172 and 173 do not recite the engagement or securement of a device to a balloon so that the device can be carried through tortuous vessel. These claims are, instead, directed to a method of dilating a stent or stent-graft.

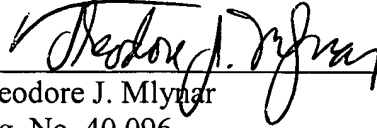
Nevertheless, Schubert makes no suggestion of such a method either. Schubert discloses blade structures for cutting. The inflation of a Schubert device within a stent or stent-graft would likely cause significant damage to the stent or stent-graft since the blades of Schubert would tend to cut the stent or stent-graft. Such mutilation of the stent or stent-graft device would be plainly inconsistent with an effort to deploy such a device.

Applicants note that Claim 79 was not specifically rejected. Clarification is requested.

Early and favorable consideration of the foregoing amendments and remarks are earnestly requested.

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Respectfully submitted,



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